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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/320,947	05/26/99	ULRICH	R 001580-500

021839 LM01/0718  
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POST OFFICE BOX 1404  
ALEXANDRIA VA 22313-1404

EXAMINER

NGUYEN, P

ART UNIT	PAPER NUMBER
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2772

DATE MAILED:

07/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/320,947

Applicant(s)  
ULRICH et al.

Examiner  
Phu K. Nguyen

Group Art Unit  
2772



☒ Responsive to communication(s) filed on May 9, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 15-29 is/are pending in the application

Of the above, claim(s) none is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 15-29 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

*Phu K. Nguyen*  
PHU K. NGUYEN  
PRIMARY EXAMINER  
GROUP 2400

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2772

1. Claims 15-29 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 5,963,206 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: sets of objects can be grouped into themes to provide a user with the dynamically switchable themes.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### RESPONSE TO APPLICANT'S ARGUMENTS

Applicant fails to adequately address/ response to this rejection cited in paragraph 1 of the prior office action (Paper No. 3). Therefore, this rejection is maintained.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-29 are rejected under 35 USC 103(a) as being unpatentable over Shrader et al. (5,900,874).

Art Unit: 2772

The rationale for this rejection is provided in paragraph 3 of the prior office action (Paper No. 3). Applicant's arguments filed May 9, 2000 have been fully considered but they are not deemed to be persuasive. Specifically, Applicant fails to provide the definition of the "theme" in the claims as "coordinated designs of interface objects and object parts that create a distinct visual appearance on the display" as Applicant argued. Furthermore, Shrader's transformed icons are not completely different objects from the original icons since the functions of the original icon and the transformed icon are closely related to each other and therefore can be called "correspond in function" as claimed. Accordingly, the claimed invention as represented in the claims does not represent a patentable distinction over the art of record.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2772

*Conclusion*

3. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)-308-9051 (**formal** communications intended for entry), Or:

(703)-305-9724 (**informal** communications labeled **PROPOSED** or **DRAFT**).

Hand-delivered responses should be brought to:

Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phu K. Nguyen, whose telephone number is (703)-305-9796 and can normally be reached Monday-Friday from 6:30 AM to 3 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-3900.

Phu K. Nguyen

Patent Examiner

Art Unit 2772

  
PHU K. NGUYEN  
PRIMARY EXAMINER  
GROUP 2400